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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,347	09/22/2003	Teruyuki Maruyama	243043US2	7039

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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LAI, MICHAEL C

ART UNIT	PAPER NUMBER
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2457

NOTIFICATION DATE	DELIVERY MODE
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10/06/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/665,347	<b>Applicant(s)</b> MARUYAMA, TERUYUKI	
	<b>Examiner</b> MICHAEL C. LAI	<b>Art Unit</b> 2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 76-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 76-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/17/2010</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This office action is responsive to amendment filed on 7/27/2010.

#### ***Response to Amendment***

2. The examiner has acknowledged the amended claims 76, 81, and 82. The objection to the specification for the incorrect incorporation of reference has been corrected and withdrawn accordingly. The 112 second paragraph rejection to claim 82 has been corrected and withdrawn accordingly. Claims 76-82 are pending.

#### ***Response to Arguments***

3. Applicant's arguments, see pages 8-10, with respect to "Ferlitsch fails to disclose an image forming apparatus including a second printing unit and a document management unit configured to, in response to receipt of a second transmission request for the second image data or the second document from the other image forming apparatus, transmit the second image data or the second document stored therein to the other image forming apparatus (including a first printing unit that is configured to print the first image data or the first document ) via the communication unit" and "Ferlitsch does not disclose that the client computing device 902 and the imaging device 904 each include a printing unit that is configured to print image data or a document", are not persuasive.

Ferlitsch discloses a peer-to-peer printing system bypassing any print server. In Ferlitsch's system, files are shared among image forming apparatuses [see at least Fig. 9 and col. 12, lines 5-17]. In another word, an image forming

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apparatus is configured to serve both as a document source apparatus and a document destination apparatus. When the image forming apparatus receives a request for a document (stored in the image forming apparatus) from another image forming apparatus, the image forming apparatus is configured to transmit the requested document to the another image forming apparatus. Thus indeed Ferlitsch meets the limitation.

Ferlitsch further discloses a Print Subsystem 912 in the client computing device 902 for handling print jobs [see at least Fig. 9 and col. 12, lines 5-17]. Since Applicant does not define exactly what "printing unit" is, Ferlitsch's Print Subsystem 912 qualifies as a printing unit. Thus Ferlitsch indeed teaches that the client computing device 902 and the imaging device 904 (a printer) each include a printing unit that is configured to print image data or a document.

Thus, in view of such, the rejection is sustained as follows:

#### ***Specification***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 76 and 82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 76 recites the limitation of “...the other image forming apparatus including a first printing unit that is configured to print the first image data or the first document...” in lines 7-8. It is unclear how **the other** image forming apparatus obtains the first image data or the first document, since the preamble indicates that the first image data or the first document is stored in **another** image forming apparatus.

Claim 82 recites the limitations of “...cause **the information processing apparatus** to transmit to the document source apparatus a transmission request for print setting information **to be used by the document source apparatus...**” in lines 5-8, and “...in response to the transmission request for the print setting information from **the document destination apparatus**, cause the information processing apparatus to transmit the print setting information to the document destination apparatus...” in lines 17-20. These two limitations are contradicting to each other. It is also unclear which apparatus actually has the print setting information.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

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to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 76, 79-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata (US 6,778,289 B1, hereinafter Iwata), and in view of Ferlitsch (US 7,471,407 B2, hereinafter Ferlitsch).

Regarding claim 76, Iwata discloses an image forming apparatus [Fig. 4, E101 Printer] configured to serve as a document destination apparatus for receiving and printing first image data or a first document stored in another image forming apparatus, the image forming apparatus comprising:

a communication unit configured to communicate with the other image forming apparatus connected via a network [Fig. 3, P106 LAN Interface and col. 5, lines 33-36];

a document reception unit configured to transmit a first transmission request for the first image data or the first document to the other image forming apparatus and to receive the first image data or the first document stored in the other image forming apparatus via the communication unit [Fig. 6, M108 Document Data Acquisition Unit and col. 8, lines 43-56];

a second printing unit configured to print the first image data or the first document received from the other image forming apparatus via the document reception unit [Fig. 3, P107 Print Engine, col. 5, lines 36-38, and col. 8, lines 50-56];

a print execution unit configured to use the printing unit to print the first image data or the first document received from the other image forming apparatus via

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the document reception unit [Fig. 6, M109 Image Rendering Unit, M110 Image Forming Unit and col. 9, lines 15-22];

a document storage unit configured to store the second image data or the second document [Fig. 3, P103 RAM and col. 5, lines 27-30].

Iwata discloses the claimed invention except for wherein the image forming apparatus is configured to serve as a document source apparatus having a document management unit configured to, in response to receipt of a second transmission request for the second image data or the second document from the other image forming apparatus including a first printing unit that is configured to print the first image data or the first document, transmit the second image data or the second document stored therein to the other image forming apparatus via the communication unit. Ferlitsch teaches peer-to-peer printing system bypassing any print server. In Ferlitsch's system, files are shared among image forming apparatuses. Ferlitsch further discloses a Print Subsystem 912 in the client computing device 902 for handling print jobs [see at least Fig. 9 and col. 12, lines 5-17]. Since Applicant does not define exactly what "printing unit" is, Ferlitsch's Print Subsystem 912 qualifies as a printing unit. Thus Ferlitsch indeed teaches that the client computing device 902 and the imaging device 904 (a printer) each include a printing unit that is configured to print image data or a document. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Ferlitsch's teaching into Iwata's system for the purpose of bypassing any print server by configuring the image

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forming apparatus also as a document source apparatus for transmitting second image data or a second document stored therein to the other image forming apparatus, thereby creating a true P2P file sharing network.

Regarding claim 79, Iwata further discloses wherein the network comprises a wired LAN or a wireless LAN [Fig. 3 and 4].

Regarding claim 80, Iwata discloses an image forming system comprising: a document destination apparatus being coupled to a document source apparatus via a network, the document destination apparatus including

a second printing unit configured to print the image data or the document [Fig. 3, P107 Print Engine, col. 5, lines 36-38, and col. 8, lines 50-56],

a document reception unit configured to transmit the transmission request for the image data or the document to the document source apparatus and to receive the image data or the document stored in the document source apparatus via the communication unit [Fig. 6, M108 Document Data Acquisition Unit and col. 8, lines 43-56],

a print execution unit configured to use the second printing unit to print the image data or the document received from the document source apparatus via the document reception unit [Fig. 6, M109 Image Rendering Unit, M110 Image Forming Unit and col. 9, lines 15-22].

Iwata discloses the claimed invention except for a document source apparatus including a document storage unit configured to store image data or a document, a first printing unit configured to print the image data or the document,



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and a document management unit configured to, in response to receipt of a transmission request for the image data or the document from a document destination apparatus, transmit the image data or the document stored therein to the document destination apparatus via a communication unit. Ferlitsch teaches peer-to-peer printing system bypassing any print server. In Ferlitsch's system, files are shared among image forming apparatuses [col. 12, lines 5-17]. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Ferlitsch's teaching into Iwata's system for the purpose of bypassing any print server by configuring a document source apparatus for transmitting the image data or the document stored therein to the document destination apparatus via a communication unit, wherein the document source apparatus and the document destination apparatus each including a printing unit, thereby creating a true P2P file sharing network.

Regarding claim 81, Iwata discloses an image forming system comprising:  
a document destination apparatus comprising a second print forming unit of printing the image data or the document stored in the storage device [Fig. 4, E101],

an information processing apparatus being coupled to a server [Fig. 4, E103 Server] and the document destination apparatus via a network, the information processing apparatus comprising a print request unit configured to issue a print request for the image data or the document stored in the server to the document destination apparatus, the print request causing the document destination

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apparatus to communicate with the server and to acquire and print the image data or the document stored in the storage device of the server [Fig. 4, E102 Computer].

Iwata discloses the claimed invention except for a document source apparatus including a storage device configured to store image data or a document, the document source apparatus comprising a first print forming unit. Ferlitsch teaches peer-to-peer printing system bypassing any print server. In Ferlitsch's system, files are shared among image forming apparatuses. Ferlitsch further discloses a Print Subsystem 912 in the client computing device 902 for handling print jobs [see at least Fig. 9 and col. 12, lines 5-17]. Since Applicant does not define exactly what "printing unit" is, Ferlitsch's Print Subsystem 912 qualifies as a printing unit. Thus Ferlitsch indeed teaches that the client computing device 902 and the imaging device 904 (a printer) each include a printing unit that is configured to print image data or a document. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Ferlitsch's teaching into Iwata's system for the purpose of bypassing any print server by configuring a document source apparatus similar to the document destination apparatus, thereby creating a true P2P file sharing network.

Regarding claim 82, Iwata further discloses wherein the document destination apparatus comprises

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a setting information acquisition unit configured to, in response to the print request for the image data or the document stored in the storage device of the server from the information processing apparatus, cause the information processing apparatus to transmit to the document source apparatus a transmission request for print setting information to be used by the server [Fig. 6, M104 Document Information Processor and col. 7, lines 37-42];

a document acquisition unit configured to transmit a document acquisition request to the server to acquire the image data or the document from the server [Fig. 6, M108 Document Data Acquisition Unit and col. 8, lines 43-56]; wherein the second print forming unit is configured to print the image data or the document stored in the server based on the print setting information [Fig. 3, P107 Print Engine, col. 5, lines 36-38, and col. 8, lines 50-56; Fig. 6, M109 Image Rendering Unit, M110 Image Forming Unit and col. 9, lines 15-22].

Iwata discloses the claimed invention except for: a setting information transmission unit and a document transmission unit for the document source apparatus. As discussed above, Ferlitsch teaches peer-to-peer printing system bypassing any print server. In Ferlitsch's system, files are shared among image forming apparatuses. Ferlitsch further discloses a Print Subsystem 912 in the client computing device 902 for handling print jobs [see at least Fig. 9 and col. 12, lines 5-17]. Since Applicant does not define exactly what "printing unit" is, Ferlitsch's Print Subsystem 912 qualifies as a printing unit. Thus Ferlitsch indeed teaches that the client computing device 902 and the imaging device 904 (a

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printer) each include a printing unit that is configured to print image data or a document. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Ferlitsch's teaching into Iwata's system for the purpose of bypassing any print server by configuring a setting information transmission unit and a document transmission unit for the document source apparatus the same as for the document destination apparatus, thereby creating a true P2P file sharing network.

9. Claims 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata and Ferlitsch as applied to claim 76, and further in view of Butterworth et al. (US 2004/0133656 A1, hereinafter Butterworth).

Regarding claim 77, Iwata and Ferlitsch disclose the claimed invention except for wherein the document reception unit receives the first image data or the first document stored in the other image forming apparatus from the other image forming apparatus through a web service for providing the first image data or the first document in a SOAP based HTTP response in response to a SOAP based HTTP request indicative of the first transmission request for the first image data or the first document. However, Butterworth teaches that messages between clients and web services may use SOAP (Simple Object Access Protocol) based HTTP [para. 0012]. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Butterworth's teaching into Iwata's and Ferlitsch's system for the purpose of defining a uniform way of passing XML-encoded data and defining a way to perform remote procedure

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calls using HTTP (or another transport protocol) as the underlying communication protocol by using a SOAP, thereby increasing the opportunities for reuse, as the service places essentially no constraints on the platform, language, or location of its clients [para. 0012].

Regarding claim 78, Iwata and Ferlitsch disclose the claimed invention except for wherein the document management unit comprises a web service for providing the second image data or the second document in a SOAP based HTTP response in response to a SOAP based HTTP request indicative of the second transmission request for the second image data or the second document. However, Butterworth teaches that messages between clients and web services may use SOAP (Simple Object Access Protocol) based HTTP [para. 0012]. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Butterworth's teaching into Iwata's and Ferlitsch's system for the purpose of defining a uniform way of passing XML-encoded data and defining a way to perform remote procedure calls using HTTP (or another transport protocol) as the underlying communication protocol by using a SOAP, thereby increasing the opportunities for reuse, as the service places essentially no constraints on the platform, language, or location of its clients [para. 0012].

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. LAI whose telephone number is (571)270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai  
16SEP2010

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Primary Examiner, Art Unit 2457